



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/634,618

08/05/2003

Joseph S. Bowers JR.

13064US02

6586

23446

7590

04/26/2006

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

KUGEL, TIMOTHY J

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/634,618

Applicant(s)

BOWERS ET AL.

Examiner

Timothy J. Kugel

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-10 and 18.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because:

The rejection of claims 1-9 under 35 USC 102(b) as being anticipated by US Patent 5,476,580 (Thorn hereinafter), of claim 10 under 35 USC 102(a) as being anticipated by Thorn in view of US Patent 5,718,746 (Nagasawa hereinafter) and of claim 18 under 35 USC 103(a) as being unpatentable over Thorn are maintained. Applicant's arguments filed 13 April 2006 have been fully considered but they are not persuasive.

Applicant argues that the examiner does not provide an explanation as to why the addition of potassium bicarbonate in the method taught by Thorn reduces the alkalinity of the dispersion and that Thorn fails to teach reducing the alkalinity of the dispersion "by an amount effective to reduce the susceptibility of the carbon dispersion to a viscosity increase."

Regarding the reduction of alkalinity, Thorn teaches that the solution of the carbon dispersion is to be within a range of 10.7 to 11.0 and "For solutions having a pH above 11.0, additional potassium bicarbonate was added" (Example 4 Column 15 Line 35 - Column 16 Line 5)-reducing the pH is synonymous with reducing the alkalinity.

Regarding reducing the alkalinity "by an amount effective to reduce the susceptibility of the carbon dispersion to a viscosity increase", since Thorn teaches the same composition and the same process as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the reduction of susceptibility to viscosity increase of the Thorn process would inherently be the same as claimed.

Applicant further argues that Thorn fails to teach a conductivity or viscosity as claimed; however, since Thorn teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the conductivity of the Thorn composition would inherently be the same as claimed; and at the time of the invention, it would have been obvious to a person of ordinary skill in the art to reduce the viscosity of the Thorn composition to less than about 20 cps, for the purpose of improving the flow of the dispersion, since it has been held that that discovering an optimum value of a result effective variable involves only ordinary skill in the art. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA).

Applicant finally argues that Nagasawa fails to teach ammonia "in a concentration sufficient to make it susceptible to a viscosity increase when exposed to the atmosphere", however, since Nagasawa teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the susceptibility to viscosity increase of the Nagasawa composition would inherently be the same as claimed.



RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700